

REMARKS

Claims 1-15 were pending. Applicants respectfully note that claims 1-12, 14 and 15 have been amended, claims 13 and 14 have been canceled without prejudice to Applicant's right to pursue claims of the same or different scope in a continuation application, while claim 16 has been added. Support for new claim 16 may be found, *inter alia*, on page 3, line 13; page 3, line 21; page 3, line 21; page 18, line 21; page 19, lines 14-18; page 4, lines 23-25; page 9, lines 3-5; page 11, line 11; page 10, line 28 to page 11 line 10; page 13, lines 4-6; page 32 line 15; page 32; page 16, line 22-25; page 17, line 21-28; page 32, line 17; page 20, line 9-15; page 33; page 23, line 18-25; page 34; page 24, line 30 to page 26, line 27. This amendment does not involve any new matter. Entry of this amendment is respectfully requested, such that claims 1-12, and 15-16 will be pending.

Specification

(1) The Office Action asserts that the application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b) and that an abstract must be provided on a separate sheet. Applicants have amended the specification to include an abstract without adding any new matter. Accordingly, Applicants request reconsideration and withdrawal of this ground of rejection.

(2) The Office Action further objects to the specification as containing several informalities, including unmatched parentheses and a double comma. Applicants have amended the specification in all sections specifically mentioned in the Office Action as well as in additional sections identified by Applicants as containing similar errors. Accordingly, Applicants request reconsideration and withdrawal of this ground of rejection.

35 USC §112/101

(3) The Office Action asserts that claims 1-10 are indefinite under 35 U.S.C. § 122 2nd paragraph, as allegedly failing to set forth any steps involved in the method or process. The Office Action further asserts that such alleged shortcoming results in an improper definition of a process, and therefore the same claims are also rejected under 35 U.S.C. § 122.

In response to the Examiner's rejection of claims 1-10 under 35 U.S.C. §112 and 101, Applicants have amended the claims to recite method of treatment claims. Applicants further note that claim 1 has been amended to incorporate the features of canceled claim 13, and since the Examiner objected to claim 13, which depended from claim 1, but stated it would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims, claim 1 should be deemed allowable. Basis for this amendment may also be found on page 36, lines 8 to 11 of the originally-filed specification. Accordingly, Applicants request reconsideration and withdrawal of this ground of rejection.

The Office Action further noted that claims 1-10 contained minor informalities including typographical errors and unmatched parentheses. Applicants have amended the claims to obviate this ground of rejection. Accordingly, Applicants request reconsideration and withdrawal of this ground of rejection.

(4) The Office Action rejected claims 11 and 12 as being indefinite under 35 U.S.C. §112 for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as their invention. In particular, the Office Action points out three specific reasons as follows:

- (a) it is allegedly unclear if the proviso in claim 11 for formula IIB applies to other formulae;
- (b) the variable R^{5"} allegedly does not bear any relationship to formulae IVB, and the term "substituted" is misspelled;
- (c) the phrases "converting a group R¹, R², R³ or R⁴ to a group R¹, R², R³ and R⁴ respectively or to a different such group" and " to a different such group" are allegedly unclear.

In response and without conceding the correctness of the Examiner's arguments but merely to expedite allowance of the claims, Applicants have amended the claims to obviate this ground of rejection. Specifically, and in reference to (a)-(c) above, Applicants have

- (a) amended the proviso in relation to R⁶⁷ after formula (IIB) and repeated the amended proviso after each of formulae (IIIB) and (IVB);
- (b) replaced the variable R5" with R5' and corrected the term "substituted"; and
- (c) deleted the objected phrases.

Support for the amendment to claim 11 may be found, for example, on page 32, line 15 and line 17, and on page 20, lines 9-15. Accordingly, Applicants request reconsideration and withdrawal of this ground of rejection.

35 USC §102

(5) The Office Action rejects claims 11, 12, 14 and 15 under 35 U.S.C. §102 as allegedly being anticipated by Hudson et al. (WO96/09294) and Brown et al. (WO96/15118). In particular, the Office Action alleges that the compounds disclosed in these two references anticipate compounds having formula IIB, and methods of making said compounds, when formulae IIB has the following constituents:

- (i). R⁶⁶ and R⁶⁷ are both ethoxy;
- (ii) one of R⁶⁶ or R⁶⁷ is methoxy, and the other is a substituted alkoxy;
- (iii) Z is O, n=0 or 1;
- (iv) R⁹ is hydrocarbyl or heterocyclyl (i.e., phenyl or pyridyl)

Applicants traverse this ground of rejection. MPEP 2131 states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." Applicants note that claims 14 has been deleted and claims 11, 12 and 15, as amended, recite elements which are not described by the cited references, and thus are not anticipated. In claim 11, the proviso used in connection with the definition of R⁶⁷ has been amended to recite "provided that R⁶⁷ is other than unsubstituted alkoxy" (emphasis added), and thus is distinguished over the compounds of Hudson et al. or Brown et al.

The definition of R⁶⁷ has also been narrowed by deleting "fluorine". Furthermore, the definition of R⁵ in relation to formula (IIIB) has been replaced with that given on page 20 line 9-15 and the definition of R⁵ of formula (IVB) amended by deleting "halogen" and adding "–N=NR¹¹". Since amended claim 11 is novel over the references cited, claims 12 and 15, which are dependent on claim 11, are also deemed novel. Accordingly, Applicants request reconsideration and withdrawal of this ground of rejection.

Claim Objections

(6) Claims 11 and 12 are objected under CFR 1.75(c) as being in improper form, because a multiple dependent claim should refer to other claims in the alternative only. Applicants respectfully note that claims 11 and 12 are not multiply dependent claims. Accordingly, this rejection does not apply to these claims.

(7) The Office Action objects to claim 13 as being dependent on a rejected base claim, but states that it would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Since claim 13 depended on claim 1, Applicants have amended claim 1 to include all the limitations of claim 13 and have deleted claim 13. Thus, claim 1 is deemed allowable. Accordingly, Applicants request reconsideration and withdrawal of this ground of objection.

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants believe no fee is due with this response other than the three-month extension of time fee. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. ASZD-P01-601 from which the undersigned is authorized to draw.

Dated: August 3, 2004

Respectfully submitted,

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